UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,414	07/23/2001	Rodney D. Cambridge	NETAP015	4138

			EXAMINER
28875	7590	11/16/2005	FERRIS III, FRED O

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ART UNIT	PAPER NUMBER
2128	

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/911,414	CAMBRIDGE, RODNEY D.
	Examiner	Art Unit	
	Fred Ferris	2128	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>30 October 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5,6,8-22,24-32 and 34-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5,6,8-22,24-32 and 34-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>23 July 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 11112005

DETAILED ACTION

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30

August 2005 has been entered. Applicant's amendment filed on 30 October 2005 has

now cancelled claims 4, 7, 23, and 33. Claims 1-3, 5-6, 8-22, 24-32, and 34-37 remain

pending in this application.

Response to Arguments

2.   Applicant's arguments filed 30 October 2005 have been fully considered but they

are not persuasive.

Regarding applicant's response to 103(a) rejection: While the examiner

appreciates applicant's efforts in amending the claims to distinguish the claimed

invention over the prior art, the examiner submits that applicant's amendment to

independent claims 1, 20, and 27 does not clearly render the claimed invention non-

obvious for the following reasons. First, applicant's arguments that the prior art does

not teach the feature relating to the user computer and the central service computer

both having antivirus databases that are updated is not persuasive since this feature is

only recited in the preamble of the claim. Appropriate weight is given to limitations

recited in the body of the claim that are needed for purpose of antecedence. "A mere

statement of purpose or intended use in the preamble of a claim need not be

considered in finding anticipation; however, it must be considered if the language of a

preamble is necessary to give meaning to the claim" Diversitech Corp. v. Century Steps,

Inc., 7 USPQ2d 1315 (Fed. Cir. 1988); In re Stencel, 4 USPQ2d 1071 (Fed. Cir. 1987).

That is, there are no claim limitations in the body of the claim that specifically require

both the user computer and the central service computer to both have antivirus

databases. In this case, the claimed limitation only requires that "the antivirus

database" be updated. Here, the claim clearly only requires that the central service

computer, and the user computer, be configured to send new antivirus files to each

other, not that they both have antivirus databases. That is, this limitation does not

expressly specify or require that both the user computer and the central service

computer actually have antivirus databases or that both databases would be mutually

updated. MPEP 2106 recites the following supporting rational for this interpretation:

> "While it is appropriate to use the specification to determine what applicant intends a term
> to mean, a positive limitation from the specification cannot be read into a claim that does
> not impose that limitation. A broad interpretation of a claim by Office personnel will
> reduce the possibility that the claim, when issued, will be interpreted more broadly than is
> justified or intended. An applicant can always amend a claim during prosecution to better
> reflect the intended scope of the claim."

Here, the examiner suggests an amendment to independent claims 1, 20, and 27

specifically requiring both the user computer and the central service computer to have

antivirus databases that are mutually updated by the method disclosed in Figure 6 of

applicant's specification to help clarify this issue.

Second, applicant's arguments relating to the subject matter of cancelled claims

4, 7, 23, and 33, now amended into independent claims 1, 20, and 27, is not persuasive

since the recited features are rendered obvious by Hodges as follows:

- notifying central service computer of new antivirus file on user computer and user

computer inquiring whether to update antivirus database: Hodges teaches notifying

server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7) and new virus

definitions (CL5-41). (Also see: McAfee Orchestrator (Hodges background) which

provides programmable intelligent agents for reporting back any antivirus events to the

server (pp. 16), and controlling antivirus file downloads and periodic updates (pp.11-18))

- central service computer configured to periodically obtain antivirus files from the

antivirus server: Hodges teaches notifying server of user update requirements (CL9-

L53-55, CL9-L62-67, Fig. 7), new virus definitions (CL5-41), antivirus signature files

(CL8-L51-65, Fig. 5b), automatic (i.e. periodic) file updating (CL5-L29), and version

number (CL9-L47, CL16-L27). (Also see: McAfee Orchestrator (Hodges background)

which provides programmable intelligent agents for reporting back any antivirus events

to the server (pp. 16), and controlling antivirus file downloads and periodic updates

(pp.11-18))

- user computer waits for request from central service computer after notification of new

antivirus data file: Hodges teaches notifying server of user update requirements (CL9-

L53-55, CL9-L62-67, Fig. 7) and new virus definitions (CL5-41). "Waiting" for a request

from the central computer before sending a new file would obviously be necessary for

synchronization purposes. (Also see: McAfee Orchestrator (Hodges background) which

provides programmable intelligent agents for reporting back any antivirus events to the

server (pp. 16), and controlling antivirus file downloads and periodic updates (pp.11-18))

Further, and as previously noted, such features are available in commercial

antivirus products such as McAfee (disclosed in applicant's specification on page 5, line

13, and in prior art Hodges, Background) McAfee VirusScan 4.5, for example, provides

features which allow for the detection of new viruses at the local computer level, and

subsequent notification central administrator using the programmable Orchestrator

feature for configuring automatic antivirus file updates, scans, and DAT file updates.

(See: McAfee VirusScan 4.5, Product Description, page 2, Central Policy Reporting and

Advanced Enterprise Reporting, for example) Hence, a skilled artisan would have

known to use the McAfee Orchestrator programmable configuration features to realize

the realize the claimed elements relating to notifying central service computer of new

antivirus files, periodically obtaining antivirus files from the antivirus server, and waiting

for request from central service computer for sending updates. (See: "epolicy

Orchestrator" Product Guide, Version 2.0, pp. 11-18) Here the Orchestrator provides

programmable intelligent agents for reporting back any antivirus events to the server

(pp. 16), and controlling antivirus file downloads and periodic updates. (pp.11-18)

Accordingly, for the reasons set forth above and below under 103(a) rejections,

the examiner maintains the prior art rejection of claims 1-3, 5-6, 8-22, 24-32, and 34-37.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4.   Claims 1-3, 5-6, 8-22, 24-32, and 34-37 are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent 6,269,456 issued to Hodges et al in view of

U.S. Patent 6,327,594 issued to Van Huben et al.

Regarding independent claims 1, 20, and 27: Hodges teaches a method, system,

and computer code, for maintaining and updating antivirus files within a computer

network consisting of user computers, central service computer, and antivirus server.

(Abstract, Summary of Invention, Figs. 3, 4, 8, 10, 12) Hodges teaches the elements of

the claimed limitations of the present invention as follows:

- *method/system/code for maintaining updated antivirus files in computer network with, computer & central service computer having antivirus database, network connected to antivirus server:* Hodges teaches updating antivirus files in a computer network (CL4-L53-67) inclusive of a central service computer having the antivirus database (CL15-L22) and a network connected to an antivirus server (CL9-L62 to CL10-L11, Fig. 7).

- *receiving new antivirus file (database) at user computer and central service computer and updating the computer's antivirus database:* Hodges teaches receiving new antivirus files in a database (CL7-L45-63, Fig. 4) at user computer and central service computer (CL7-L1-3) and subsequently updating the computer's antivirus database (CL9-L53-55, CL9-L62-67, Fig. 7).

memory for temporary antivirus storage: The system disclosed by Hodges is obviously inclusive of memory for temporary storage of antivirus files (the system disclosed in Figs. 3 and 10 are obviously inclusive of RAM memory).

- *where the central service computer and user computer are configured to send new antivirus file to other central service computer and user computer to update the antivirus database:* Hodges discloses sending new antivirus files to the service computer and and user computer in updating the antivirus database (CL7-L1-3, 45-63, CL9-L53-55, 62-67, Figs. 4 and 7).

- *notifying central service computer of new antivirus file on user computer and user computer inquiring whether to update antivirus database*: Hodges teaches notifying server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7) and new virus definitions (CL5-41). (Also see: McAfee Orchestrator (Hodges background) which provides programmable intelligent agents for reporting back any antivirus events to the server (pp. 16), and controlling antivirus file downloads and periodic updates (pp.11-18))

- *central service computer configured to periodically obtain antivirus files from the antivirus server*: Hodges teaches notifying server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7), new virus definitions (CL5-41), antivirus signature files (CL8-L51-65, Fig. 5b), automatic (i.e. periodic) file updating (CL5-L29), and version number (CL9-L47, CL16-L27). (Also see: McAfee Orchestrator (Hodges background) which provides programmable intelligent agents for reporting back any antivirus events to the server (pp. 16), and controlling antivirus file downloads and periodic updates (pp.11-18))

- *user computer waits for request from central service computer after notification of new antivirus data file*: Hodges teaches notifying server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7) and new virus definitions (CL5-41). "Waiting" for a request from the central computer before sending a new file would obviously be necessary for synchronization purposes. (Also see: McAfee Orchestrator (Hodges background) which

provides programmable intelligent agents for reporting back any antivirus events to the

server (pp. 16), and controlling antivirus file downloads and periodic updates (pp.11-18))

Further, such features are available in commercial antivirus products such as

McAfee (disclosed in applicant's specification on page 5, line 13, and in prior art

Hodges, Background) McAfee VirusScan 4.5, for example, provides features which

allow for the detection of new viruses at the local computer level, and subsequent

notification central administrator using the programmable Orchestrator feature for

configuring automatic antivirus file updates, scans, and DAT file updates. (See: McAfee

VirusScan 4.5, Product Description, page 2, Central Policy Reporting and Advanced

Enterprise Reporting, for example) Hence, a skilled artisan would have known to use

the McAfee Orchestrator programmable configuration features to realize the realize the

claimed elements relating to notifying central service computer of new antivirus files,

periodically obtaining antivirus files from the antivirus server, and waiting for request

from central service computer for sending updates. (See: "epolicy Orchestrator" Product

Guide, Version 2.0, pp. 11-18) Here the Orchestrator provides programmable intelligent

agents for reporting back any antivirus events to the server (pp. 16), and controlling

antivirus file downloads and periodic updates. (pp.11-18)

Hodges does not explicitly disclose comparing databases between a user

computer and a host (server) computer system.

Van Huben teaches comparing the databases between central (host) computer

and user (client) computer to determine if databases require updating (i.e. new files).

(Abstract, Summary, Figs. 3a-4a) Van Huben teaches the elements of the claimed

limitations of the present invention as follows:

- comparing antivirus databases of central service computer (application) and

user computer to determine if databases contain new antivirus file not

contained within the other database: Van Huben teaches comparing databases

between central (host) computer and user computer to determine if databases require

updating of new files. (CL4-L18-33, especially L29-32)

It would have been obvious to one having ordinary skill in the art at the time the

claimed invention was made to modify the teachings of Hodges relating to updating an

antivirus database over a network, with the teachings of Van Huben relating to

comparing databases between a client and central server, to realize the claimed

invention. An obvious motivation exists since, in this case, the Hodges reference

teaches to the Van Huben reference, and the Van Huben reference teaches to the

Hodges reference. Specifically, both Hodges and Van Huben teach the maintaining and

updating databases and are used in the same technological arena as noted above.

Hodges teaches to Van Huben because Hodges discloses that client databases require

frequent updating from the central server (See: Hodges CL3-L51). Van Huben teaches

to Hodges because Van Huben specifically teaches the means for comparing

databases between a central server and a client (user) computer to facilitate updating.

(See: Van Huben: CL4-L29-32) Further, the level of skill required by an artisan to realize

the claimed limitations of the present invention is clearly established by both references.

(See: Hodges/Van Huben, Background) Accordingly, a skilled artisan having access to

the teachings of Hodges and Van Huben, would have knowingly modified the teachings

of Hodges with the teachings of Van Huben (or visa versa) to realize the claimed

elements of the present invention.

Per dependent claim 2-3, 21-22, and 24: Hodges teaches a network with multiple

users connected to a central service computer and an antivirus database for obtaining

antivirus files (CL7-L1-3, 45-63, CL9-L53-55, 62-67, Figs. 4 and 7).

Per dependent claims 5 and 6: Hodges teaches a central server connected to the

Internet and hosting a web site. (CL2-L51, Figs. 8, 10)

Per dependent claims 8-11, 14, 16-18, 24, 25, 31, 32: Hodges teaches notifying

server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7), new virus

definitions (CL5-41), antivirus signature files (CL8-L51-65, Fig. 5b), automatic file

updating (CL5-L29), and version number (CL9-L47, CL16-L27).

Per dependent claims 12-13, 26, 29, and 30: Hodges teaches detecting and

cleaning infected data files using newly updated files (CL3-L29-41, Fig. 1).

Per dependent claims 15 and 19: These claims are rendered obvious by the

teachings of Van Huben relating to comparing databases between a central server and

a client (user) computer to facilitate updating (CL4-L29-32) and hence would have

knowingly been incorporated by a skilled artisan using the reasoning previously cited

above.

Per dependent claim 28: *This claim is rendered obvious by the distribution means disclosed by Hodges that discloses antivirus file distribution by CD-ROM, Internet, etc. (See: CL1-L65 to CL2-L11)*

Per dependent claim 34: *Hodges teaches notifying server of user update requirements (CL9-L53-55, CL9-L62-67, Fig. 7) and new virus definitions (CL5-41). "Waiting" for a request from the central computer before sending a new file would obviously be necessary for synchronization purposes. Van Huben teaches comparing databases between a central server and a client (user) computer to facilitate updating (CL4-L29-32) and hence would have knowingly been incorporated by a skilled artisan using the reasoning previously cited above.*

Per dependent claims 35-37: *These claims are rendered obvious by the teachings of Van Huben relating to comparing databases between a central server and a client (user) computer to facilitate updating (CL4-L29-32) and hence would have knowingly been incorporated by a skilled artisan using the reasoning previously cited above. Hodges teaches a central server connected to the Internet and hosting a web site. (CL2-L51, Figs. 8, 10)*
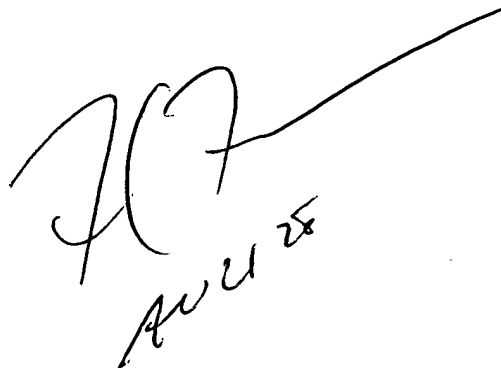
Conclusion

5.   *The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Careful consideration should be given prior to applicant's response to this Office Action.*

"Surfing the Net for Software Engineering Notes", M. Doernhoefer, ACM

SIGSOFT, Software Engineering Notes, Vol. 26, No. 2, March 2001 teaches antivirus

database updating.

U.S. Patent 6,151,643 issued to Chang et al updating client databases.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Fred Ferris whose telephone number is 571-272-3778

and whose normal working hours are 8:30am to 5:00pm Monday to Friday. Any inquiry

of a general nature relating to the status of this application should be directed to the

group receptionist whose telephone number is 571-272-3700. If attempts to reach the

examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can

be reached at 571-272-2279. The Official Fax Number is: (703) 872-9306

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